



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,324	01/21/2000	Kristin Butcher	00P7423US	5692

7590 09/13/2002

Elsa Keller
Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

WOO, ISAAC M

ART UNIT PAPER NUMBER

2172

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,324

Applicant(s)

BUTCHER, KRISTIN

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: Examination Procedures For Computer-Related Inventions.
Flowchart Analysis Worksheet

DETAILED ACTION

1. This action is in response to Applicant's Arguments, filed on June 24, 2002 have been considered but they are not persuasive.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 4-17, 23-27, 29 and 32-33 are rejected under 35 U.S.C. § 101 because:
the claimed invention is directed to non-statutory subject matter, which are
mathematical algorithm.

Claims, 4, 23, 29 and 32 to mathematical algorithm without any limitation to a practical application have been held to be non-statutory subject matter. Le Roy v. Tatham, 55 U.S. 156, 175 (1852) and Mackay Radio & Telegraph Co. V. Radio Corp. Of America, 306 U.S. 86, 94 (1939).

Claims 4-17, 23-27 29 and 32-33 are explicitly drawn to merely manipulating of numbers and too abstract idea and a pure mathematical algorithm without any limitation to a practical application. The claimed mathematical algorithm is not applied as in the claim held statutory in Diamond v. Diehr, 450 U.S. 175, 109 USPQ 1 (1981). Therefore, the claims are drawn to non-statutory subject matters.

Claims 5-17, 24-27 and 33 are rejected as being dependent upon rejected bases claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 3, 18, 21-22, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ansell et al (U.S. Patent No. 6,151,631, hereinafter, "Ansell").

With respect to claims 1, 18, 28 and 30, Ansell discloses the method for representing a given numbers with a plurality of entries, the method comprising:

determining whether a first set of numbers of the given range are representable as one or more entries that utilize wildcards, see (col. 10, lines 52-54 and col. 11, lines 1-10; Note: a given IP range is already represented with wildcard, which implies that determination step was prior to representation step with wildcard. Thus, it is inherent.);

representing the first set of numbers of the given range with one or more entries having one or more wildcards when such first set of numbers are representable as one or more entries that utilize wildcards, see (col. 11, lines 5-10); and

representing all numbers of a remaining one or more numbers of the given range that are not representable as one or more entries that utilize wildcards as entries that do not use utilize wildcards, see (col. 11, lines 1-10; e. g., for IP address, 127.56.212.*, 127.56.212 is represented without wildcard),

wherein the entries are optimized such that a minimum number of entries are used to represent the given range, see (col. 11, lines 8-10; i.e., 127.56.212.*, 127.56.213.* and 127.56.214.*, are optimized entries).

With respect to claim 3 and 21-22 Ansell discloses that each number within the given represents a router address (IP), see (col.11, lines 1-10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 19-20 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al (U.S. Patent No. 6,151,631) in view of Comito et al (U.S. Patent No. 6,195,658, hereinafter, "Comito").

With respect to claims 2, 19-20 and 31, although Ansell discloses the number within given range, he fails to explicitly disclose that the number within the given range represents a phone number. However, Comito teaches that the number within the given range represents a phone number, see (col. 9, lines 12-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the system of wildcard representation of Comito for phone number into the system of Ansell. One of ordinary skill in the art would have been motivated to combine Ansell with the teaching of Comito. In order to save data storage for huge data of tens of millions of telephone numbers, the data representation with wildcard (the most common way to compact data to reduce data size) is very efficient method. Especially, for the given range of any types of numbers, it will save huge amount of database storage.

Response to Arguments

8. In response to Applicant's remarks filed on June 24, 2002, the following factual arguments are noted:

a. Ansell does not disclose representing first set of numbers with wildcards, representing remaining numbers without wildcards of the given range that are not representable with wildcards as claimed in claim 1, 18, 28 and 30, in stead, Ansell discloses the representing whole range of numbers.

b. Rejection under 35 U.S.C. § 101 to claims 4-17, 23-27 29 and 32-33.

In considering (a). Applicant contends that Ansell does not disclose the representing first set of numbers, representing remaining numbers without wildcards of the given range that are not representable with wildcards as claimed in claim 1, 18, 28 and 30. However, Ansell discloses the first set of numbers (127.56.212.*, *, is considered as first set of numbers when 127.56.212.* to 127.56.214.* are whole range of numbers) representing with wildcards and remaining range numbers are representing without wildcards (127.56.212). The applicant's used the term "range", is too broad, thus, examiner considers the entire range of numbers are between 127.56.212.* and 127.56.214.* and considers the first set of numbers are "*" and remaining all numbers are 127.56.212 and 127.56.214.

9. In considering (b), Applicant contends that disclosed computer-related invention has practical application in the technological arts claimed in claims 4, 23, 29 and 32.

Examiner processes to determine if disclosed computer-related invention has practical application in the technological arts based upon attached paper "Examination Procedures For Computer-Related Inventions".

At the Box 12, the process goes to Box 13. Disclosed invention claimed in claims 4, 23, 29 and 32 does not have practical application. Because "Range Optimization Algorithm" is totally based upon pure mathematical algorithm and merely manipulate mathematical numbers. Thus, at the Box13, the process goes to Box 15. Therefore, the claims 4, 23, 29 and 32 are drawn to non-statutory subject matters.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2172

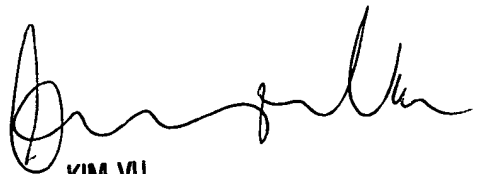
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

IMW
September 9, 2002



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100